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Hideo Tsukazaki

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EXAMINER

COPPOLA, JACOB C

ART UNIT

PAPER NUMBER

3621

NOTIFICATION DATE

DELIVERY MODE

10/29/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/518,797	<b>Applicant(s)</b> TSUKAZAKI ET AL.	
	<b>Examiner</b> JACOB C. COPPOLA	<b>Art Unit</b> 3621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 August 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 14-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination under 37 C.F.R. §1.114***

1. A request for continued examination (“RCE”) under 37 C.F.R. §1.114, including the fee set forth in 37 C.F.R. §1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 C.F.R. §1.114, and the fee set forth in 37 C.F.R. §1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 C.F.R. §1.114. Applicants’ submission filed on 17 August 2009 has been entered.

### ***Acknowledgements***

2. This action is in reply to the amendments to the claims and remarks filed on 17 August 2009 (“09 Aug Response”).
3. Claims 1-26 are currently pending.
4. Claims 14-26 were previously withdrawn in the Office action mailed on 16 October 2008 (Paper No. 20080924, p. 2).
5. Claims 1-13 have been examined.
6. This Office Action is given Paper No. 20091021. This Paper No. is for reference purposes only.

***Specification***

7. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. §1.75(d)(1) and MPEP §608.01(o). Correction of at least the following is respectfully requested:

a. The examined claims recite “electronic point amount.” This phrase lacks antecedent basis in the written description.

***Claim Rejections - 35 USC §112, 2<sup>nd</sup> Paragraph***

8. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-13 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

***Regarding Claims 1-13***

10. Claim 1 recites “an electronic points purchase request, the electronic points for purchasing said predetermined contents.” Claim 1 is indefinite because the recitation of “the electronic points” lacks antecedent basis. Claim 1 positively recites an “electronic points purchase *request*,” but does not positively recite “electronic points,” thus making it unclear to what “the electronic points” is referring.

b. Claims 8, 12, and 13 are rejected for the same reason.

Art Unit: 3621

11. Claim 1 recites “a table associating said content IDs with an electronic point amount.”

Claim 1 is indefinite because it is unclear how the association is made. For example, does the table contain an amount for each content ID?

c. Claims 6-8, 12, and 13 are rejected for the same reason.

12. Claim 1 recites “reception means for receiving both a table associating said content IDs with an electronic point amount, and a utilization condition each transmitted by said server in response to said request by said request means.” Claim 1 is indefinite because it is unclear whether the “associating” refers to both the “electronic point amount” and the “utilization condition.”

d. Claims 8, 12, and 13 are rejected for the same reason.

13. Claim 1 recites “reception means for receiving both a table associating said content IDs with an electronic point amount, and a utilization condition each transmitted by said server in response to said request by said request means.” Claim 1 is indefinite because it is unclear to what “both” is referring. This is caused by the irregular placement of a comma after “amount.”

14. Claim 1 recites “a utilization condition each transmitted by said server in response to said request by said request means.” Claim 1 is indefinite because “said request” lacks antecedent basis. Claim 1 positively recites a “request means for requesting,” but does not positively recite a “request,” thus making it unclear to what “said request” is referring.

e. Claims 8, 12, and 13 are rejected for the same reason.

15. Claim 1 recites “said utilization-condition storage means being further a means for updating said table on the basis of a content ID and an update of said electronic point amount.” Claim 1 is indefinite because it is unclear whether “said electronic point amount” refers to the

Art Unit: 3621

“available electronic point amount” or the electronic point amount associated, by the table, to the content IDs.

16. Claim 6 recites “an update of said electronic point count.” This phrase lacks antecedent basis. It is unclear whether this phrase refers to an electronic point amount or to something else.

f. Claim 7 is rejected for the same reason.

***Regarding Claims 1-5 and 8-11***

17. The following claim elements are means-plus-function limitations that invoke 35 U.S.C. §112, sixth paragraph.

g. The “request means for requesting utilization of predetermined contents...,”

h. The “reception means for receiving both a table... and a utilization condition...,”

i. The “utilization-condition storage means for storing said utilization condition and said table...,”

j. The “utilization execution means for executing utilization of said predetermined contents...,”

k. The “utilization-condition transmission means for transmitting said table... and for transmitting said utilization condition...,”

l. The “sales-history information storage means for storing sales-history information of said predetermined contents...”

m. The “collection means for collecting sales records of contents utilized by said terminal...,”

Art Unit: 3621

n. The “processing execution means for carrying out processing based on said sales records...,”

o. The “acquisition means for acquiring execution-history information...,”

p. The “utilization-history information storage means for storing utilization-history information...,”

q. The “favorite extraction means for extracting information of contents...,”

r. The “execution-history information storage means for storing execution-history information...,” and

s. The “execution-history information transmission means for transmitting said execution-history information....”

18. However, the written description fails to disclose the corresponding structure for the claimed function. Additionally the written description fails to clearly link or associate the disclosed structure to the claimed function such that one of ordinary skill in the art would recognize what structure performs the claimed function.

19. Applicants are required to either:

t. Amend the claims so that the claim limitations will no longer be means plus function limitations under 35 U.S.C. §112, sixth paragraph; or

u. Amend the written description of the specification such that it expressly recites what structure performs the claimed function without introducing any new matter (35 U.S.C. §132(a)), and amend the written description of the specification such that it clearly links or associates the corresponding structure to the claimed function without introducing any new matter (35 U.S.C. 132(a)).

Art Unit: 3621

20. If Applicants are of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure so that one of ordinary skill in the art would recognize what structure performs the claimed function, Applicants are required to amend the written description of the specification such that it expressly recites the corresponding structure for performing the claimed function and clearly links or associates the structure to the claimed function, without introducing any new matter. See 35 U.S.C. §132(a).

***Regarding Claims 6 and 7***

21. The phrase “electronic point amount” is indefinite because—to one of ordinary skill in this art—the metes and bounds of the phrase cannot be reasonably determined. To support this position, the Examiner notes the following: First, the Examiner has carefully reviewed the original specification and cannot locate a lexicographic definition with the required clarity, deliberateness, and precision. Second, although the Examiner recognizes that each word within the phrase may have a particular meaning, the arrangement of these words within the context of this phrase does not reasonably apprise one of ordinary skill in this art the overall meaning of the claimed phrase. Third, the Examiner has again reviewed all documents of record in conjunction with MPEP §2141.03 including the original specification and claims. Therefore based at least upon the three points noted above and using the required precepts of English grammar, it is the Examiner’s position that the phrase “electronic point amount” (as used in the context of these particular claims) is neither lexicographically defined by Applicants nor known to those of ordinary skill in this art. However, if Applicants believe that the phrase is old and well known in the art, Applicants should (in their next appropriately filed response) expressly state on the



Art Unit: 3621

record that the phrase is old and well known in the art and provide appropriate evidence in support thereof (*e.g.* a U.S. patent). Upon receiving (1) Applicants' express statement that the phrase is old and well known in the art and (2) sufficient evidence in support thereof, the Examiner will withdraw this particular 35 U.S.C. §112, 2nd paragraph rejection.

***Regarding Claim 8***

22. Claim 8 is indefinite because it is considered a hybrid claim. See MPEP §2173.05(p) II. In particular, the claims are directed to neither a "process" or a "machine" but rather embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C. §101.

23. For example, claim 8 recites "An information-processing apparatus." In light of this evidence, one of ordinary skill in the art could reasonably interpret these recitations as express intent by Applicants to claim a machine claim.

24. Alternatively, claim 8 recites a conditional process (*i.e.*, "when a content ID and an update... are received from said server, said... means updates said table..."). One of ordinary skill in the art could also reasonably interpret these recitations as express intent by Applicants to claim a process claim. In light of this conflicting evidence, a person of ordinary skill in the art could reasonably interpret claim 8 to be drawn to either a product or process.

25. Therefore in accordance with §2173.05(p) II which states that a single claim must be drawn to either a product or process (but not both) and because a potential competitor of Applicants would not know whether *possession alone* of the claimed structure constituted infringement, or alternatively, if infringement required the *execution* of the recited method steps, the claims are indefinite.

Art Unit: 3621

26. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112 2<sup>nd</sup> paragraph, it is impossible to properly construe claim scope at this time. See *Honeywell International Inc. v. ITC*, 68 USPQ2d 1023, 1030 (Fed. Cir. 2003) (“Because the claims are indefinite, the claims, by definition, cannot be construed.”). However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied *as much as practically possible*.

### ***Claim Rejections - 35 USC §103***

27. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

28. Claims 1-13, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Higashi et al. (U.S. 2004/0249759 A1) (“Higashi”), in view of Yodo (E.P. 1,071,031 A1).

### ***Regarding Claims 1, 2, 6-8, 12, and 13***

29. Higashi discloses:

a content-providing system comprising a terminal (“content using apparatus **103**”) for utilizing contents and a server (distribution center **101**) connected to said terminal through a

Art Unit: 3621

network (“network **102**”) and used for managing said contents comprising: said terminal including storage means (“content storage unit **203**”) for storing said contents in advance; request means (“user interface unit” and “billing unit **211**”) for requesting utilization of predetermined contents by transmitting content IDs identifying said predetermined contents among a plurality of said contents stored in said storage means, to said server; reception means (“broadcast receiving unit **201**”) for receiving both a table associating said content IDs with an electronic point amount, and a utilization condition each transmitted by said server in response to said request by said request means (“LT **404**”), said utilization condition including an available electronic point amount determined based on the points purchase request; utilization-condition storage means (“content use management unit **215**”) for storing said utilization condition and said table, which are received by said reception means, said utilization-condition storage means being further a means for updating said table on the basis of a content ID and an update of said electronic point amount, which are received from said server; and utilization execution means (“content use control unit **212**”) for executing utilization of said predetermined contents on the basis of said utilization condition and said table, which have been stored in said utilization-condition storage means; said server including utilization-condition transmission means (“right management server **101b**” and “value information distribution server **101d**”) for transmitting said table associating said content IDs with said electronic point amount and for transmitting said utilization condition, to said terminal; sales-history information storage means (“right management server **101b**”) for storing sales-history information of said predetermined contents pertaining to said range as information including said content IDs identifying said predetermined contents, utilization of which is requested by said request means employed in said terminal;

Art Unit: 3621

collection means (“right management server **101b**”) for collecting sales records of contents utilized by said terminal on the basis of said sales-history information stored in said sales-history information storage means; and processing execution means (“right management server **101b**” and “value information distribution server **101d**”) for carrying out processing based on said sales records,

wherein said utilization-condition transmission means, employed in said server, is further a means for transmitting a content ID, and an update of said electronic point amount (figs. 1, 2, and 5 with associated text; ¶ 0117; ¶¶ 0159+).

30. Higashi does not directly disclose:

request means for requesting utilization of predetermined contents by transmitting an electronic points purchase request, the electronic points for purchasing said predetermined contents.

31. Yodo teaches:

request means for requesting utilization of predetermined contents by transmitting an electronic points purchase request, the electronic points for purchasing said predetermined contents (¶ 0172).

32. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the request means of Higashi to include the functionality of Yodo in order to allow the user to obtain points without having to buy content, as in Higashi.

Art Unit: 3621

***Regarding Claim 3***

33. Higashi further discloses wherein said sales-history information stored in said sales-history information storage means further includes an apparatus ID used for identifying said terminal (figs. 1, 2, and 5 with associated text; ¶ 0117; ¶¶ 0159+).

***Regarding Claim 4***

34. Higashi further discloses an acquisition means for acquiring execution-history information representing a history of executions of utilizations of said contents stored in said terminal; and utilization-history information storage means for storing utilization-history information including said content ID received from said server and said execution-history information acquired by said acquisition means, wherein said collection means further collects utilization records of contents utilized by said terminal on the basis of said utilization-history information (figs. 1, 2, and 5 with associated text; ¶ 0117; ¶¶ 0159+).

***Regarding Claim 5***

35. Higashi further discloses a favorite extraction means for extracting information of contents each serving as a favorite with a user using said terminal on the basis of said utilization-history information stored in said utilization-history information storage means and information on favorites stored in said terminal, wherein said transmission means transmits information extracted by said favorite extraction means as said information of contents each serving as a favorite with said user using said terminal to said terminal (figs. 1, 2, and 5 with associated text; ¶ 0117; ¶¶ 0159+).

***Regarding Claim 9***

36. Higashi further discloses an ID storage means for storing an apparatus ID used for identifying said information-processing apparatus, wherein said request means transmits said apparatus ID from said ID storage means along with said content IDs of said predetermined contents pertaining to said range to be purchased and said electronic point amount for purchasing said predetermined contents in order to make said request for utilization of said predetermined contents pertaining to said range (figs. 1, 2, and 5 with associated text; ¶ 0117; ¶¶ 0159+).

***Regarding Claim 10***

37. Higashi further discloses an execution-history information storage means for storing execution-history information representing a history of executions of utilizations of said predetermined contents; and execution-history information transmission means for transmitting said execution-history information stored in said execution-history information storage means to said server (figs. 1, 2, and 5 with associated text; ¶ 0117; ¶¶ 0159+).

Art Unit: 3621

***Regarding Claim 11***

38. Higashi further discloses said reception means further receives information on favorite contents of a user using said information-processing apparatus from said server as information based on said execution-history information; and said utilization execution means executes utilizations of said predetermined contents on the basis of said information on favorite contents (figs. 1, 2, and 5 with associated text; ¶ 0117; ¶¶ 0159+).

***Claim Interpretation***

39. Regarding the conditional elements in the claims (*e.g.* claim 12 recites “an update... when said content ID... are received”), they too have been considered. However, Applicants are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See *e.g.* MPEP §2106 II C: “Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.” (emphasis in original).

40. With respect to the functional language of claims 1-5 and 8-11, Applicant is respectfully reminded “[A]pparatus claims cover what a device *is*, not what a device *does*.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). See also MPEP §2114.

***Response to Arguments***

***Objections to the Specification***

41. The Examiner notes that the USPTO's Board of Patent Appeal and Interferences ("Board") has recently recognized that the lack of antecedent basis of claim terms in the original specification as a "significant problem." See 73 Fed. Reg. 32944 (June 10, 2008) (noting that "[o]ne significant problem faced by the Board under Rule 41.37(c)(1)(v) occurs when the language of a claim does not have direct antecedent language in the specification.").

42. Additionally, the Examiner notes that patent examiners have no authority to waive the provisions of a rule. See *In re Goodman*, 3 USPQ2d 1866, 1871 (ComrPats 1987) noting the examiners have no authority to waive 37 C.F.R. §1.111(b).

43. Because the lack of antecedent basis is currently recognized by the USPTO as a significant problem and because the Examiner has no authority to waive the provisions of a rule, correction of the noted objections to the specification under 37 C.F.R. § 1.75(d)(1) is still required.

***35 U.S.C. §112, 2<sup>nd</sup> Paragraph***

44. Applicants state:

With regard to item 18, the outstanding Action cites In re Morris 44 USPQ 2d at 1029, as providing support for the position that Applicants have a burden to specifically identify the corresponding structure for each means element recited in the claims, Applicants respectfully this assertion and submit that this case does not provide this burden.

See pp. 19-20, 09 Aug Response (emphasis in original).



Art Unit: 3621

45. Applicants' opinion has been acknowledged. The Examiner maintains his position that its *Applicants'* burden to define their invention, *not* the USPTO's.

46. Applicants argue "However, Applicants note that there is a burden that exists in the case; specifically, the Office has a burden to provide a prima facie case of *lack of written description*." See p. 20, 09 Aug Response (emphasis added). Applicants point to *In re Alton* (76 F.3d 1168, 1175 (Fed. Cir. 1996)) in support of their position. It appears that Applicants are arguing against a "lack of written description" rejection, which the Examiner assumes to be a rejection under 35 U.S.C. §112, First Paragraph, commonly referred to as a "lack of written description." Because the Examiner has *not* given a rejection under 35 U.S.C. §112, First Paragraph, this argument is moot. Additionally, because the Examiner has *not* given a rejection under 35 U.S.C. §112, First Paragraph, *In re Alton* is not applicable.

47. Applicants argue "In the present case, the outstanding Action has provided no reasoning regarding why 'the written description fails to disclose the corresponding structure, material, or acts for the claimed function.'" See 09 Aug Response, p. 20. The Examiner respectfully disagrees. The Examiner's reason is simple. The Examiner has carefully read, reviewed, and searched the written description and can neither find nor clearly link and associate the corresponding structure to the claimed means plus function elements (see rejection under 35 U.S.C. §112 2nd paragraph above). Again, because Applicants' desire the USPTO to define Applicants' claims, Applicants arguments are strikingly similar to the applicant's arguments in *Morris*.

Art Unit: 3621

48. In other words and from the Examiner's viewpoint, this issue is very easily addressed by Applicants: for each phrase that invokes 35 U.S.C. §112, 6th paragraph, Applicants must clearly linking and associate the claimed structure to the claimed function.

49. The other arguments regarding the examined claims are moot in view of the new grounds of rejection.

### ***Conclusion***

50. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure (see attached form PTO-892).

51. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

52. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 3621

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private

PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/JACOB C. COPPOLA/

Patent Examiner, Art Unit 3621

October 21, 2009

/ANDREW J. FISCHER/

Supervisory Patent Examiner, Art Unit 3621